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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,012	07/31/2003	Yassir Abdul-Hafiz	MASIMO.339A	9340
20995	7590	11/22/2005		
KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			EXAMINER NATARAJAN, VIVEK	
			ART UNIT	PAPER NUMBER
			3735	

DATE MAILED: 11/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Tm

Office Action Summary	Application No. 10/632,012	Applicant(s) ABDUL-HAFIZ ET AL.	
	Examiner Vivek Natarajan	Art Unit 3735	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/23/05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) 1-20 and 37-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/31/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/2/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Invention II, Claims 21-36 in the reply filed on 9/23/05 is acknowledged.
2. Claims 1-20 and 37-39 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made without traverse in the reply filed on 9/23/05.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 21-24, 27-30 and 33-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Awazu et al. (US Patent No. 4,974,591).
3. Regarding Claims 21 and 27, Awazu discloses a sensor circuit comprising a flexible circuit substrate 1, a pair of pads 12, 13 disposed on an optical portion of the substrate, a plurality of pinouts 30, 40 disposed on a connector portion 20, and a plurality of conductive paths 15. The first pad 13 is configured to mount a detector A3 and the second pad 12 is configured to mount an emitter at either the 2a or 2b

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positions, with the 2b position located a predetermined distance further from the detector A3 than the 2a position (see Figs. 4 and 5 and the description thereof in col. 4, line 27 – col. 5, line 16).

4. Regarding Claim 33, Awazu discloses a sensor circuit method comprising the steps of predetermining a plurality of emitter-detector spacings based on the shape and length of a patient's finger, configuring a pad to mount an emitter or detector at a plurality of positions corresponding to these spacings, and mounting the emitter or detector to a particular one of these positions (see Figs. 8a-8c and the description thereof in col. 5, lines 36-59).

5. Regarding Claims 22-23, 28-29 and 35-36, the second pad comprises a first contact set 206 and a second contact set 205 electrically connected in parallel, wherein the emitter is mountable to the contact set 206 in the 2a/202 position at a lesser distance from the detector A3 or to the contact set 205 in the 2b/203 position at a greater distance from the detector A3 (see the description of Fig. 4 above and also Fig. 13a and its description in col. 6, lines 47-67).

6. Regarding Claims 24, 30 and 34, the sensor circuit comprises an elongated aperture 208 through which light is transmitted from the emitter when it is mounted in either the first position 203 or the second position 202 (see Figs. 13a and 14).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 21, 25-27 and 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Awazu et al. Awazu discloses a sensor circuit comprising a flexible circuit substrate 1, a pair of pads 12, 13 disposed on an optical portion of the substrate, a plurality of pinouts 30, 40 disposed on a connector portion 20, and a plurality of conductive paths 15. The first pad 13 is configured to mount a detector A3 and the second pad 12 is configured to mount an emitter at either the 2a or 2b positions, with the 2b position located a predetermined distance further from the detector A3 than the 2a position. Awazu further notes that the shape and length of the measurement site may vary from person to person, and indicates that the detector and emitter should be spaced accordingly to fit each person specifically (col. 5, lines 36-59). He does not disclose the particular emitter-detector spacing distances for different patients. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize a sensor circuit and determine the optimal emitter-detector spacing distances corresponding to different patient sizes and to operate the sensor using this particular spacing as taught by Awazu since this allows for optimization of measurements.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. New, Jr. et al. (US Patent No. 4,700,708) teaches adjusting the

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emitter-detector spacing of an oximeter sensor based on the size of the appendage to be encountered (col. 5, lines 3-22).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivek Natarajan whose telephone number is (571)272-6249. The examiner can normally be reached on Mon-Fri, 8:00-4:30.

11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ali Imam can be reached on (571)272-4737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

VN


ERIC F. WINAKUR
PRIMARY EXAMINER